

Appl. No. 09/844,175

REMARKS

The Examiner has required restriction under 35 U.S.C. §121 between claims 31-42, 54-65, and 67-70 (Group I) and claims 66, 71, and 72 (Group II). Applicants hereby elect with traverse claims 31-42, 54-65, and 67-70 (Group I) for prosecution on the merits. Claims 66, 71, and 72 (Group II) have been canceled without prejudice.

Applicants submit restriction at this point of the prosecution is improper. The claims have been allegedly substantively examined three times by the Office. In fact, the claims of group II were previously indicated to be allowable or not rejected over the art. During the interview (interview summary enclosed), the Examiner indicated he is not sure if any claims are allowable even though at least some of the claims of group II were previously indicated to be allowable.

No claims have been presented which were not previously examined. Applicants refer the Examiner to MPEP §808.02 (8th ed.) entitled "Related Inventions." It is stated in such MPEP section that where related inventions as claimed are shown to be distinct under MPEP §806.05(c) (the alleged section or rationale for issuing the restriction requirement in the subject application), the Examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (a) separate classification, (b) separate status in the art when they are classifiable together, or (c) a different field of search. It is further stated in MPEP §808.02 that where the classification is the same and field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.

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The restriction requirement is entirely devoid of identifying any indication of separate future classification or field of search let alone clear indication as required. Page 3 of the Office Action states that the inventions are distinct and have required a separate status in the art because of their recognized divergent subject matter with absolutely no support provided. Section B of MPEP 808.02 states that separate status in the art may be shown by citing patents which are evidence of such separate status, and also separate field of search. *No patents have been cited or other evidence offered to indicate the alleged separate status. In addition no separate field of search is required inasmuch as all pending claims have been examined on the merits in numerous Office Actions and some claims were rejected over the prior art.* There is no indication that a different classification is provided or a different field of search is required. In fact, the restriction requirement indicates the class and subclass is the same for both groups I, II of claims. No clear indication of separate future classification and field of search is provided. As mandated by MPEP §808.02, no reasons exists for dividing among related inventions.

Applicant further contends that any restriction is improper for at least the following reasons. First, the Examiner has apparently already searched all pending claims which are now the subject of restriction. Accordingly, now requiring elimination of any set of claims will not reduce the scope of searching, and thus there are no efficiencies gained by imposing a restriction requirement.

Second, this application is in a chain of numerous previously-examined applications. The collective subject matter has therefore already been searched in the parent applications. Accordingly, there are no searching efficiencies gained by invoking

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restriction now at this overly late date. Restriction at this late time is not timely, and does not have any sense of fairness to Applicant.

Third, there is increased burden on the U.S. Patent and Trademark Office, on the Applicant and ultimately on the public in prosecuting multiple separate patent applications. For Applicant, splitting the invention into multiple cases increases costs associated with government fees, prosecution fees, and maintenance fees for multiple patents. For the PTO, there are increased costs associated with conducting multiple searches in multiple applications and multiple examinations for an invention that already has been searched and examined. It further ultimately produces a burden on the pertinent public that will review Applicant's commonly patented technology. Such people will be compelled to unnecessarily review multiple issued patents and file histories.

For at least these reasons, Applicant respectfully asserts that the Examiner's restriction requirement is improper, and requests that the Examiner withdraw the restriction requirement and consider the already examined claims in this application at this time. In the event the restriction is not withdrawn, Applicant provisionally elects Group I as mentioned above.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

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Respectfully submitted,

Dated: 7/3/03

By:


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